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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,832	01/16/2004	William Robert Mass	279.B36US1	7138
21186 7590 01/13/2009 SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER				
MANUEL, GEORGE C				
ART UNIT		PAPER NUMBER		
3762				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/758,832

Applicant(s)

MASS ET AL.

Examiner

George Manuel

Art Unit

3762

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9-18 and 20-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9-18 and 20-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

Claims 1, 2, 4-7, 9-18 and 20-30 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

Controllers 160, 260, and 360 lack specific and substantial elements. The specification states the switches 162, 262, and 362 are controlled by their respective controllers 160, 260, and 360; however, the specification lacks specific circuitry elements to enable one of ordinary skill in the art to construct the controllers to enable the function of controlling. FIGS. 3-5 merely show blocks labeled "controller" without elements shown to provide for activation of the disclosed switches. It doesn't appear obvious to one having ordinary skill in the art how the controllers could be made to perform their function of controlling their switches without undue experimentation.

The claim amendments, filed 9/29/08 fail to correct the above specified specification deficiencies.

Claim Rejections - 35 USC § 112

Claims 1, 2, 4-7, 9-18 and 20-30 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 2 and 18 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Von Arx et al (US 6,993,393).

Von Arx et al disclose both the implantable device 100 and the external device 200 are battery powered. Coil 150B is configured to transmit and receive data to and from telemetry coil 150A.

Device therapy circuit 280 provides a signal based on remaining battery capacity to microprocessor 260 which is inherently powered by a battery voltage source rated for the microprocessor. Telemetry control circuit 290 includes circuitry adapted for controlling telemetry functions relative to the modules coupled to telemetry data bus 215 and is inherently powered by a battery voltage source rated to provide telemetry at an expected higher amount than the rating required for the microprocessor.

Claims 12 and 15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Itoga et al (US 5,122,729).

Itoga et al disclose a first battery comprising battery 9, a controller comprising an AC/DC conversion circuit 8. Circuit 8 is shown to be in parallel with the battery 9. The examiner is interpreting the detection coil 12 to be capable of detecting "data" from the

secondary coil 7 comprising changes in induced voltage resulting from changes in distance between the primary coil 3 and the secondary coil 7.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Arx et al (US 6,993,393) in view of Nelms (US 4,323,074).

In the alternative to microprocessor 260 being inherently powered by a battery voltage source rated for the microprocessor and telemetry control circuit 290 including circuitry adapted for controlling telemetry functions relative to the modules coupled to telemetry data bus 215 and being inherently powered by a battery voltage source rated to provide telemetry at an expected higher amount than the rating required for the microprocessor, it would be obvious to do so based on the teaching of Nelms.

Nelms teaches the transmitter 42 requires the higher voltage level to operate during the transmission of the encoded signal via the coupled coil 70 to the pacemaker 16. During those times of transmission, the "READY" signal is generated from the P17 terminal of the microprocessor 40 and is applied through transition point A to the base

of transistor Q1, whereby the energizing coil of the relay 66 is energized to throw the switches from the position as shown in FIG. 7A to the other position, whereby the batteries BT1 and BT2 normally connected in parallel are now connected in a series configuration to provide a high level voltage via terminal P18 to the transmitter 42. The microprocessor 40 operates on a battery voltage of 5 volts. The transmitter 42 is energized with 18 volts.

Claims 1, 2, 4, 11, 16, 18, 22, 23, 24, 25, 26, 27, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoga et al (US 5,122,729) in view of Nelms (US 4,323,074).

Itoga et al show all of the claimed features except for an implanted device or a switch.

One of ordinary skill in the art would have found it obvious to use the teaching of Itoga et al with an implanted device because the inductive coupling does not require a "hard wired" circuitry and because it is well known to use telemetric devices with implanted devices to avoid the need to pass wires through the skin.

Regarding the feature of a switch, one of ordinary skill in the art would have found it obvious to provide a switch to the battery 9 to control current through the coil 7 because the coil 7 when powered provides a signal that is detectable and when it is desirable not to detect the coil current, a switch is a common component to insert to interrupt current flow.

One of ordinary skill in the art would have found it obvious to combine the varying voltage teachings of Nelms for the transmitter in the device of Itoga et al to conserve power and to not over power the microprocessor by using two separate battery sources.

Response to Arguments

Applicant's arguments filed 9/29/08 have been fully considered but they are not persuasive. The remarks directed toward Von Arx not disclosing inductive telemetry are without merit. Near field module 220, in one embodiment, includes an inductively coupled transmitter/receiver 140A, as described relative to FIG. 1. In addition, Von Arx discloses a battery powered telemetry coil. Von Arx teaches portable external devices may also be battery powered, and recharging or replacement of the battery in such devices is an inconvenience.

Applicant's argument that sensing or detecting a voltage as disclosed in Itoga is not "communicating data with inductive telemetry" is without merit. Itoga teaches the detection coil 12 detects and outputs as a change in the induction voltage any load fluctuation resulting from a change in the distance between the primary coil 3 and the secondary coil 7. This change in induction is clearly a fact or piece of information and the value is derived from a type of scientific experiment, thus rendering the change as data. Further, the data is given from coil 7 to coil 3 based on their separated distance. If the distance is too great, the information indicates coil 3 needs to be placed closer to coil 7. Fluctuations in coil 7 voltage are also measured. See col. 2, lines 25-35.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Manuel whose telephone number is (571) 272-4952.

/George Manuel/
Primary Examiner
Art Unit: 3762